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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,153	08/21/2003	Jeong-Kyu Moon	678-1123 (P10535)	8920
28249	7590	11/21/2005	EXAMINER	
DILWORTH & BARRESE, LLP 333 EARLE OVERTON BLVD. UNIONDALE, NY 11553			DESIR, PIERRE LOUIS	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/646,153

Applicant(s)

MOON, JEONG-KYU

Examiner

Pierre-Louis Desir

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 09/06/2005 have been fully considered but they are not persuasive.

Applicant argues, regarding claim 1, that Nomani discloses a portable radio communication apparatus that does not allow a user to determine a button to associate a message with as evidenced by the fact that Nomani requires the use of a read only memory.

Examiner respectfully disagrees with Applicant's assertions. Nomani discloses a case of forming a message of a company name "MELCO," wherein the control section selects "message forming" upon an operation of FCN key (user input). And, when a certain numeral key is pressed (for e.g., a number of times), the control section selects a specific character corresponding to the pressing of specific key. After the message is complete, the control section registers the message to the pre-message memory (i.e., storing the message associated with the pressing of the specific keys) (see col. 7, lines 21-33).

Applicant argues, regarding independent claims 4 and 8, that Moran discloses a messaging system and method, which requires a user to first determine if a feature key is pressed and then enter a directory number. Moran, adds Applicant, merely discloses transmitting a message a after pressing a telephone number of a second party and inputting the number, whereas Claims 4 and 8 of the application clearly disclose transmitting a message to a called mobile terminal while a calling mobile terminal attempts to establish a call connection with the called mobile terminal.

For the rejection of claims 4 and 8, Examiner relies on the combination of Nomani and Moran. Examiner did not assert in the previous rejection that Moran discloses, “attempting to establish a call connection...” for that limitation is covered by the Nomani’s reference. Applicant is respectfully invited in arguing that specific point as related to Nomani’s reference.

For the sake of argument, Examiner respectfully disagrees with Applicant’s statement that claims 4 and 8 clearly disclose transmitting a message to a called mobile terminal while a calling mobile terminal attempts to establish a call connection with the called mobile terminal, because the claim language, as written, only discloses that the method comprising the steps of “attempting to establish a call connection...; and if the call connection between the mobile terminal is not established, pressing a..., and transmitting a message...” Thus, the steps of attempting to establish a connection and the steps of if the call connection is not established to transmit a message (as the written) does not take place during the same place, as applicant argues.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 3 is rejected under 35 U.S.C. 102(e) as being anticipated by Nonami, U.S. Patent No. 6647258.

Regarding claim 1, Nonami discloses a method for storing a message for use in a one-touch call operation using a mobile terminal (see abstract), comprising the steps of: selecting a one-touch call menu command of the mobile terminal (i.e., P key serving as one-touch dialing key) (see fig. 20, col. 6, line 1); determining by a user a button to be used for the one-touch call operation (Nonami discloses that the P key serves as one-touch dialing key for an instant originating of call to already registered phone numbers) (see col. 6, lines 1-4, and col. 7, lines 21-33); entering a message to be transmitted to a counterpart mobile terminal when performing the one-touch call operation (i.e., the control section selects "call office at xx:xx" from the fixed message upon an operation of the END key. The control section then inputs "03:00" to "xx:xx" by an operation of the numeral keys in the operation section. Thus, the inputting represents the step of entering a message to be transmitted) (see col. 6, lines 41-52, and col. 7, lines 21-33); and storing the message associated with the determined button (Nonami discloses a case of forming a message of a company name "MELCO," wherein the control section selects "message forming" upon an operation of FCN key (user input). And, when a certain numeral key is pressed (for e.g., a number of times), the control section selects a specific character corresponding to the pressing of specific key. After the message is complete, the control section registers the message to the pre-message memory) (see col. 7, lines 21-33).

Regarding claim 3, Nonami discloses a method (see claim 1 rejection) wherein the message is text message (see col. 6, lines 41-52).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nonami in view of Moran, Pub. No. US 2002/0073142.

Regarding claim 2, Nonami discloses a method as described above (see claim 1 rejection).

Although, Nonami discloses a method as described, Nonami does not specifically disclose a method wherein the message is a recorded voice message.

However, Moran discloses a method of storing a message wherein the message is a voice message (see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation for doing so would have been to facilitate the sending of different kind of messages.

Regarding claim 4, Nonami discloses a method for performing a one-touch call operation using a mobile terminal, comprising the step of: attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal (i.e., Nonami discloses a portable phone comprising of a P key serving as "one-touch" dialing key for an instant originating of call to already registered phone numbers, and SEND key serving as transmitting/receiving key. Nonami further disclosed that upon a transmission operation (SEND key), the formed message is then

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transmitted from the antenna. Thus, one skilled in the art would undoubtedly conceptualize that the pressing of the end key characterizes the attempt to establish a call connection) (see col. 2, lines 4-8; col. 6, lines 1-5).

Although, Nonami discloses a method as described, Nonami does not specifically disclose a method comprising the step of: if the call connection between the mobile terminal and the counterpart mobile terminal is not established, pressing a one-touch call button of the mobile terminal, and transmitting a predetermined message to the counterpart mobile terminal using a one-touch call processing.

However, Moran discloses a method (with the service of voice mail or answering services, which would present that the destination party's unavailability to receive the call; therefore, the call is diverted to voice mail or answering services) wherein a user is able to send a pre-recorded message by pressing a particular function key on a telephone handset (see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation for doing so would have been to facilitate the sending of messages to the destination party.

Regarding claims 5-7, Nonami discloses a method as described above (see claim 4 rejection).

Although Nonami discloses a method as described, Nonami does not specifically disclose wherein the step pressing the one-touch call button of the mobile terminal, includes the steps of: reading out a phone number of the mobile terminal and the predetermined message from a memory of the mobile terminal; and simultaneously transmitting the phone number of the mobile terminal and the predetermined message to the counterpart mobile terminal.

However, Moran discloses a method wherein a messaging server is arranged to store one or more pre-specified messages, wherein the pre-specified message can be a standard message containing the originator's details (i.e., phone number, name) and a request to be called back. Moran further discloses the step of receiving an input from a user, indicating that the pre-specified message is to be sent to the destination party, and sending the pre-specified message to the destination party mailbox (see page 1, paragraphs 8-12). Nonami further discloses, as related to claim 6 and 7, a method wherein the predetermined message is a previously voice message or text message (i.e., pre-recorded voice or text message) (see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art to combine both arts to arrive at the claimed invention. A motivation for doing so would have been to provide a messaging system, which overcomes the tedious routine of repeating one's name, phone number, and time of call (see paragraph 3).

Regarding claims 8-10, Nonami discloses a method for performing a one-touch call operation using a mobile terminal, comprising the step of: attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal (i.e., Nonami discloses a portable phone comprising of a P key serving as "one-touch" dialing key for an instant originating of call to already registered phone numbers, and SEND key serving as transmitting/receiving key. Nonami further disclosed that upon a transmission operation (SEND key), the formed message is then transmitted from the antenna. Thus, one skilled in the art would undoubtedly conceptualize that the pressing of the end key characterizes the attempt to establish a call connection) (see col. 2, lines 4-8; col. 6, lines 1-5).

Although, Nonami discloses a method as described, Nonami does not specifically disclose a method comprising the steps of: if the call connection between the mobile terminal and the counterpart mobile terminal is not established, pressing a one-touch call button of the mobile terminal for performing the one-touch call operation; and transmitting a phone number of the mobile terminal and a predetermined message to the counterpart mobile terminal.

However, Moran discloses a method (with the service of voice mail or answering services, which would present that the destination party's unavailability to receive the call; therefore, the call is diverted to voice mail or answering services) wherein a user is able to send a pre-recorded message by pressing a particular function key on a telephone handset (see abstract). Moran further discloses the step of transmitting a phone number of the mobile terminal and a predetermined message to the counterpart mobile terminal (i.e., a messaging server is arranged to store one or more pre-specified messages, wherein the pre-specified message can be a standard message containing the originator's details (i.e., phone number, name) and a request to be called back. Moran further discloses the step of receiving an input from a user, indicating that the pre-specified message is to be sent to the destination party, and sending the pre-specified message to the destination party mailbox) (see page 1, paragraphs 8-12). And as related to claims 9-10, Moran further discloses a method wherein the predetermined message is a previously voice message or text message (i.e., pre-recorded voice or text message) (see abstract).

Therefore, it would have been obvious to one of ordinary skill in the art to combine both arts to arrive at the claimed invention. A motivation for doing so would have been to provide a messaging system, which overcomes the tedious routine of repeating one's name, phone number, and time of call (see paragraph 3).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre-Louis Desir whose telephone number is (571) 272-779. The examiner can normally be reached on Monday-Friday 8:00AM- 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre-Louis Desir
AU 2681
11/13/2005



JOSEPH FEILD
SUPERVISORY PATENT EXAMINER